

### **Remarks**

This is a response to the office action mailed September 28, 2004. Claims 1-19 were originally filed in this application. Claims 1-16 and 20-29 were previously prosecuted in the parent application. Claims 30-45 were added by preliminary amendment. Claims 33-45 were withdrawn with traverse by Applicant in response to the July 20, 2004 Restriction Requirement. By way of this office action, the Examiner additionally withdraws claims 18, 19 and 30.

In this first Office Action, the Examiner rejects claims 17, 31 and 32 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,323,782, issued to Stephens et al. (hereinafter "Stephens"). The Examiner further rejects claim 17 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,791,450, issued to Gokcebay (hereinafter "Gokcebay"). Finally, the Examiner rejects claims 17 and 31 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,688,435 issued to Will et al. (hereinafter "Will"). Reconsideration and reexamination of the application as amended is respectfully requested.

**A. Claims Presented in the Application after the Restriction Requirement**

In the Restriction Requirement issued by the Examiner on July 20, 2004, the Examiner indicated that none of the claims presented by Applicant were generic. Applicant traversed this restriction and elected Species I, subspecies A, directed to claims 17-19 and 30-32 wherein biometric information is collected with a camera.

The Examiner, by way of this office action, further withdrew claims 18, 19 and 30 as being drawn to non-elected subject matter. Applicant strenuously disagrees with the Examiner's interpretation. Applicant believes that claim 17 is generic to all claims presented in this application, namely, 18-19 and 30-45.

Claims 18, 19 and 30 are directed to various biometric input detection systems which are incorporated as part of the method of automating package pick-up and delivery.

While Applicant elected a particular subspecies to pursue in response to the restriction requirement, it is understood that more than one biometric input device may be used to collect biometric information. For example, a user may authenticate his identity by entering information with the use of an input pad while communicating with a service center via a camera and video conference system. It is understood that fingerprint and/or iris pattern information may also be collected with the camera and vide conference system. Thus, Applicant suggests that claims 18, 19 and 30 should be examined with this application.

Applicant respectfully submits that claim 17 is generic to claims 33-45. Claim 17 relates to a method of automating package pick-up and delivery. Claims 33-40 relate to a method of automating package drop-off and delivery encompassing additional elements of claim 17, namely, the collection and processing of package delivery information. Claims 41-45of relate to a method of automating package drop-off and delivery encompassing additional elements of claim 17, namely, the collection and processing of package delivery information along with the collection and comparison of biometric information to deliver the package. Since claim 17 is generic to both aspects of the invention, claims 18, 19, 30 and 33-35 should be reinstated into this application for examination.

***B. Rejections Under 35 U.S.C. §102(b)***

The Examiner rejects claims 17, 31 and 32 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,323,782, issued to Stephens et al. (hereinafter "Stephens").

In order to maintain the §102 rejection, MPEP §2131 requires that:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the ... claim.

(Emphasis added). It is clearly evident that the Stephens reference does not disclose the identical invention as that claimed by Applicant.

Stephens discloses the use of both internal and external cameras for security purposes, capturing images of possible tampering of the storage container. These cameras do not allow for interactive communication between an external host and the storage container. This functionality is required by Applicant's claimed invention. Further, Stephens requires the use of complex transponders integrated into both the package and delivery systems to receive or deliver packages, which is clearly not part of Applicant's claimed invention.

Stephens fails to incorporate a device which collects and compares biometric input, such as an iris scanner, audio conference system or camera/video conference arranged to acquire any number of biometric outputs. Applicant's system discloses and claims a method of automating package pick-up and delivery utilizing an information input system which collects and compares biometric input from a customer.

The biometric input devices are arranged to detect and uniquely identify the package recipient prior to delivery of the package. Two-way communication between the delivery station and an off-site attendant through a video conferencing system allows direct communication between the recipient and attendant. The delivery station reviews the biometric input prior to releasing the package for delivery to the recipient. Since Stephens fails to disclose the identical invention as that claimed by Applicant, Applicant respectfully requests reconsideration of the claims as amended. As such, Applicant respectfully submits that claims 17-19 and 30-32 are in condition for allowance

**C. Rejections Under 35 U.S.C. §102(e)**

The Examiner rejects claim 17 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,791,450, issued to Gokcebay (hereinafter "Gokcebay"). The Examiner further rejects claims 17 and 31 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,688,435 issued to Will et al. (hereinafter "Will").

The relevant portion of 35 U.S.C. §102(e) is reproduced below:

(e) the invention was described in. . . (2) a **patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent**, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(Emphasis added). The Examiner applies the Will reference to reject claims 17 and 31 under 35 U.S.C. §102(e). However, Will is not an appropriate §102(e) reference.

The Will '435 patent, granted February 10, 2004, was filed October 31, 2001. Applicant's constructive reduction to practice date is at least the filing date of Applicant's application, September 13, 2001. Since Applicant's constructive reduction to practice date predates the Will filing date, Will is not an appropriate 35 U.S.C. §102(e) reference. Thus, claims 17 and 31 are in condition for allowance.

The Examiner additionally rejects claim 17 as being anticipated by Gokcebay. Gokcebay fails to teach or disclose the identical invention as that claimed by Applicant. Gokcebay discloses that a biometric credential may be used to identify a user to unlock a locker compartment. However, Gokcebay limits the type of credentials to number codes or passwords and does not contemplate collection of biometric input such as voice, signatures, iris patterns, fingerprints, or facial identification. Thus, Gokcebay does not disclose the identical invention. Applicant submits that claim 17 is in condition for allowance.


**D. Conclusion**

Applicant has made a genuine effort to respond to each of the Examiner's objections and rejections in advancing the prosecution of this case. Applicant believes that all formal and substantive requirements for patentability have been met and that this case is in condition for allowance, which action is respectfully requested. If any additional issues need to be resolved, the Examiner is requested to telephone the undersigned at his convenience.

A check in the amount of \$60.00 is enclosed to cover the Petition fee of \$60.00. Please charge any additional fees or credit any overpayments as a result of the filing of this paper to our Deposit Account No. 02-3978.

Respectfully submitted,

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